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Elizabeth Miller
Elizabeth Miller

March 11, 2002
Date

ATTY DOCKET No. 10010326-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Herbert F. Cattell et al. Group Art Unit: 1634
Serial No.: 09/919,555 Examiner: Betty J. Forman
Filed: July 31, 2001
Title: CHEMICAL ARRAY READING

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

RESPONSE TO RESTRICTION REQUIREMENT

The Examiner is thanked for the Office Action mailed 02/08/02 (restriction requirement only). The Action has an attached page "Attachment for PTO-948" on how to effect drawing corrections. However, no PTO-948 form was included nor does the Office Action Summary page indicate any objections to the drawings. It is assumed then that there are no drawing objections on this application at this time.

In response to the restriction requirement, Applicants hereby elects Group I (claims 1-16) with traverse with respect to Groups III and V, and without traverse in relation to Groups II, IV, and VI. Since Groups II, IV, and VI are non-elected without traverse, any issue of restriction between these Groups becomes moot in the present application and Applicant reserves the right to traverse a restriction as between those three Groups in any subsequent divisional application.

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With regard to the traversal in relation to Groups III and V, claims 1, 32 and 40 are reproduced below from each of Groups I, III, and V, respectively:

1. A method of generating an addressable array of chemical moieties on a substrate, comprising:

- (a) depositing the moieties onto different regions of the substrate so as to fabricate the array;
- (b) saving in a memory array related data, which array related data may comprise any of data on a characteristic of the fabricated array, an instruction for reading an array, or an instruction on processing data from a read array;
- (c) shipping the fabricated array, and forwarding the array related data to a remote location.

32. An apparatus for producing an addressable array of biopolymers on a substrate, comprising:

- (a) an array fabricator to deposit the biopolymers onto different regions of the substrate so as to fabricate the array;
- (b) a processor to save in a memory array related data, which array related data may comprise any of data on a characteristic of the fabricated array, an instruction for reading an array, or an instruction on processing data from a read array, which array related data is saved in a memory association with an identifier.

40. A computer program product, comprising: a computer readable storage medium having a computer program stored thereon for performing, when loaded into a computer communicating with a fabricator to fabricate an addressable array of biopolymers on a substrate, the method of:

- (a) depositing the moieties onto different regions of the substrate so as to fabricate the array; and
- (b) saving in a memory array related data, which array related data may comprise any of data on a characteristic of the fabricated array, an instruction for reading an array, or an instruction on processing data from a read array.

The apparatus and computer program product of claims 32, 40 both recite execution of steps (a) and (b) in the method claim 1. As such, examining claims 32, 40 together with claim 1 would not place any "serious burden" on the Examiner since in examining claim 40 the Examiner should also again search in the classifications relating to claim 1 (since it is possible references which are material in relation to method claim 1 might also be material to the apparatus and computer program product claims 32 and 40). As pointed out in MPEP 803 "If the search and examination of an entire application can be made without serious burden, the

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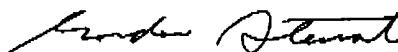
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examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

In any event Applicants reminds the Examiner that in making the restriction requirement between the identified Groups or species the Examiner, at least implicitly, is acknowledging that each identified Group and species is patentable over the other. This is so since for any restriction MPEP 802.01 requires that each of the subjects of the restriction must be “PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)”. Thus, after making a restriction requirement, if the Examiner finds a reference disclosing only what is disclosed in a claim of one Group, it would be logically inconsistent to then make a novelty or obviousness rejection of a claim of another Group based solely on such a reference since the Examiner has already taken the position that the claim of the another Group is novel and unobvious over the claim of the one Group. For example, if the Examiner finds a reference which ONLY discloses the computer program product of claim 40, it would be logically inconsistent for her to then reject claim 1 based on that reference since under MPEP 802.01 she has already found that claim 1 is novel and unobvious over claim 40.

Should the Examiner have any questions or believe there are any outstanding issues that might be resolved by means of a telephone conference, she is invited to call Gordon Stewart at (650)485-2386.
telephone conference, she is invited to call Gordon Stewart at (650)485-2386.

Respectfully submitted,



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